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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/646,520 | 08/22/2003 | Duane D. Adams | 240-098PA | 8909 |

26500 7590 01/13/2005
LAWRENCE P. TRAPANI, ESQ.
PO BOX 555
MANLIUS, NY 13104-0555

EXAMINER

PICKETT, JOHN G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3728

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/646,520 | Applicant(s) ADAMS, DUANE D. | |
| | Examiner Gregory Pickett | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tisbo (Des. 385,920) in view of Sato et al (US 3,927,767), Polhemus et al (US 4,768,298), and Mayo (US 5,727,766).

Tisbo discloses a desk organizer tray with a tray portion (portion with receptacles) and a bottom plate having an extension portion (see Figures 1 and 2). Tisbo lacks, or does not expressly disclose, the means for fabrication, specifically the tray portion made from a plurality of superimposed board members, nor the means for attaching a desk pad.

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Sato et al discloses the formation of a tray 10 with a plurality of superimposed boards (13a-13h) to enable the tray to act as a buffer as well as a receptacle (see for example Col. 1, lines 49-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the tray of Tisbo from superimposed layers as taught by Sato et al in order to enable the tray to act as a buffer as well as a receptacle.

Polhemus et al suggests the provision of a mechanical fastening means 28 to join desktop elements together (See for example Col. 1, lines 36-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Tisbo-Sato with a mechanical fastening means as suggested by Polhemus et al in order to enable the joining of desktop elements.

Tisbo-Sato-Polhemus discloses the claimed invention except that a clasp is used as a fastening means instead of an adhesive strip. Mayo shows that an adhesive strip 22 was an equivalent structure known in the art for the joining of elements of desktop articles. Therefore, because these two fastening means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the adhesive strip of Mayo for the clasp of Tisbo-Sato-Polhemus.

As to claims 2-5, the receptacles of Tisbo-Sato-Polhemus-Mayo are configured to retain the claimed articles.

As to claim 6, Tisbo-Sato-Polhemus-Mayo discloses a plurality of receptacles (see Tisbo Figure 1).

As to claims 7 and 8, Tisbo-Sato-Polhemus-Mayo discloses finger recesses (Sato, area between tabs 29).

As to claim 9, the length of the extension of Tisbo-Sato-Polhemus-Mayo is sized as claimed.

As to claim 13, Mayo discloses double sided tape 22.

As to claim 14, since adhesive is a form of glue, Tisbo-Sato-Polhemus-Mayo discloses the claimed invention.

2. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tisbo-Sato-Polhemus-Mayo as applied to claim 1 above, and further in view of Tracy et al (US 3,744,435).

Tisbo-Sato-Polhemus-Mayo discloses the claimed invention except for the length for the extension. Tracy et al shows that extensions of the claimed length were known in the art at the time the invention was made. It would have been an obvious matter of design choice to provide the extension in the claimed size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tisbo-Sato-Polhemus-Mayo-Tracy as applied to claim 10 above, and further in view of McMullen (US 1,331,995).

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Tisbo-Sato-Polhemus-Mayo-Tracy discloses the claimed invention except for the corner pockets.

McMullen discloses corner pockets 4 for the retention of desk pads 5 & 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Tisbo-Sato-Polhemus-Mayo-Tracy with corner pockets as taught by McMullen in order to securely retain the desk pad.

4. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tisbo-Sato-Polhemus-Mayo as applied to claim 1 above, and further in view of McMullen.

Regarding claim 15, Tisbo-Sato-Polhemus-Mayo merely lacks the desk pad.

McMullen discloses the attachment of a desk pad 1 to a tray 7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Tisbo-Sato-Polhemus-Mayo with an attached desk pad as taught by McMullen in order to protect the surface of the desk from scratches.

As to claim 16, the examiner takes Official Notice that the provision of calendar as the desk pad was old and well known in the art at the time the invention was made, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the desk pad of Tisbo-Sato-Polhemus-Mayo-McMullen as a calendar in order to enable the user to schedule appointments.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such

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challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice.

See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

Regarding claims 17 and 18, *Tisbo-Sato-Polhemus-Mayo-McMullen*, as applied to claim 15 above discloses the claimed invention; the method being met by presentation.

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
6 January 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700